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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,668	07/02/2003	Gunter Holzner	81455-5560	7260

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EXAMINER

LAMM, MARINA

ART UNIT PAPER NUMBER

1616

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/613,668	Applicant(s) HOLZNER ET AL.	
	Examiner Marina Lamm	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-25 is/are pending in the application.  
     4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-7, 10-14 and 23-25 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 11/12/04. Claims pending are 1-7 and 10-25. Claims 8 and 9 have been cancelled. Claims 1, 2, 4, 7 and 10 have been amended. Claims 15-25 are new. Claims 15-22 have been withdrawn from further consideration. See below. Claims 1-7, 10-14 and 23-25 are being examined at this time.

### ***Election/Restrictions***

1. Newly submitted claims 15-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to a different, patentably distinct method of making perfuming or flavoring microcapsules.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-18 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Newly submitted claims 19-22 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to another patentably distinct method of making perfuming or flavoring microcapsules.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 19-22 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Double Patenting***

3. Applicant is advised that should claim 2 be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-6, 13 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eden et al. (US 4,812,445).

Eden et al. teach flavors and odor producing substances encapsulated in a starch matrix containing 10-20% of a salt such as ammonium monobasic or dibasic phosphate. See Abstract; col. 2, lines 3-11; col. 3, lines 3-5, 27-30. The amount of the core material (e.g. flavor or fragrance) can be in the range of 0.1-80% by weight. See col. 2, lines 16-19. Eden et al. teaches food products containing encapsulated food flavoring oil. See Example 3. While teaching ammonium monobasic or dibasic phosphate among other salts, the reference does not explicitly teach the claimed combination of flavoring

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or perfuming ingredient and ammonium phosphate. However, the reference teaches all the elements of the instant claims and exemplify a combination of volatile scent oil and ammonium sulfate. The selection of optimal species of salt within the reference's generic disclosure is within the skill of ordinary practitioner. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Eden et al. such that to combine a flavoring or odorous ingredient with ammonium phosphate. One having ordinary skill in the art would have been motivated to do this because the reference teaches using ammonium phosphate among other salts for the same purpose.

6. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eden et al. (US 4,812,445) either alone or in view of Soeda et al. (US 6,475,542), of record.

a. Eden et al. alone.

Eden et al. applied as above. With respect to Claim 7, Eden et al. teach adding the salt to starch slurry, then adding the material to be encapsulated to the dispersion, spreading the resultant mixture on a chilled surface, recovering the encapsulated material in sheet form and cutting or grinding and drying the resultant starch-encapsulated material. See col. 1, lines 40-57. Further, Eden et al. teaches that spray-drying method of encapsulation is known in the art, although it is less preferable for some materials having high volatility and intended for application in natural, humid environment. See col. 2, lines 20-34. Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the claimed invention was made to use a conventional spray drying method for encapsulation of materials of Eden et al. with a reasonable expectation of success depending on the intended use and/or volatility of the core material. With respect to Claim 14, the claim is in product-by-process format. The Courts have held that process limitations cannot impart patentability to a product which is not patentably distinguished over the prior art. See in *In re Thorpe et al.* (CAFC 1985) 771 F2d 695, 227 USPQ 964.

b. Eden et al. in view of Soeda et al.

Eden et al. applied as above. The reference does not explicitly teach the claimed step of spray-drying the emulsion to form a powder. However, Soeda et al. teach various methods for encapsulating edible materials, including spray-drying method. Soeda et al. teach that the method is fast and "has been in wide use as a means for finely granulating a liquid substance". See col. 1, lines 18-35; col. 2, lines 40-43. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of encapsulating of Eden et al. such that to spray dry the resultant dispersion instead of drying it on the surface and then grinding the resultant sheet. One having ordinary skill in the art would have been motivated to do this to obtain faster process, which can be automated as suggested by Soeda et al.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eden et al. (US 4,812,445) in view of Murphy et al. (US 6,555,098), of record.

Eden et al. applied as above. While teaching microcapsules containing odorous materials (fragrant oils), Eden et al. do not explicitly teach perfumed products of the instant claim. However, Murphy et al. teach using microencapsulated fragrances in cosmetic deodorant products for providing aroma. See Abstract; col. 1, lines 54-57. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the encapsulated odor producing materials of Eden et al. in cosmetic products. One having ordinary skill in the art would have been motivated to do this to obtain deodorant effect as suggested by Murphy et al. With respect to Claim 12, the claim is in product-by-process format. The Courts have held that process limitations cannot impart patentability to a product which is not patentably distinguished over the prior art. See in *In re Thorpe et al.* (CAFC 1985) 771 F2d 695, 227 USPQ 964.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-7 and 10-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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